

REMARKS

As a result of this amendment, claims 1-9, 14, 15, 17, and 19-49 are now pending in this application. All the claims stand rejected under 35 USC §102(e).

Applicant reserves all applicable rights not asserted in or with this response, including, for example, the right to rebut tacit and explicit characterizations of one or more cited references, and the right to swear behind one or more cited references. Additionally, applicant regards all the cited art, as merely art of record, and makes no admissions regarding the prior-art status of any of the cited references.

Interview Summary

Applicant acknowledges the courtesy extended by Examiners Field and Nguyen in granting an interview on July 21, 2002 with its patent counsel Eduardo Drake. Several of the claims were discussed in relation to Horowitz (U.S. 6,122,647). As a result of the interview, applicant's patent counsel believed that at least dependent claim 21, which requires that the generated hyperlink include at least one query connector, had been identified as allowable. However, the Examiner's Interview Summary does not indicate that an agreement was reached. Further, applicant notes that Examiner Field indicated a willingness to withdraw finality given some apparent misinterpretations of Horowitz relative to at least some of the dependent claims.

Supplemental Information Disclosure Statement

Applicant respectfully renews its request that a signed copy of the 1449 Form, acknowledging consideration of all references submitted with the Supplemental Information Disclosure Statement filed on February 10, 2000, be returned with the next official communication.

Response to §102 Rejections

The Examiner rejected claims 1-9, 14, 15, 17 and 19-49 under 35 USC §102(e) as anticipated by Horowitz (U.S. 6,122,647). Applicant respectfully submits that each of the rejected claims distinguishes from Horowitz.

Claims 1-5

Regarding claims 1-5, applicant submits that these claims have been amended to more readily distinguish from Horowitz. Specifically, these claims have been amended to require acts, steps, or means for “searching one or more documents for content having one or more predefined forms.” Additionally, these amended claims clarify that the act, step for, or means for marking the document is performed automatically and that the automatic marking is done to one or more of the documents on which the searched for the predefined forms was conducted.

In contrast, Horowitz appears to generate a hyperlink for a document by conducting a search of a knowledge base (130) based on user-selected or user-marked portion of a source document. See, for example, column 2, lines 45-48, which states that “a system and method [dynamically generate] contextual hypertext links in a source document to other topically relevant documents in response to the content of the source document or user-selected portion thereof.”

Applicant found nothing in Horowitz to indicate that it searches its source document (that is, the document that hyperlinks are to be place in) for predefined forms. One example of such a form, recited in claim 19, is a citation to a printed publication.

At best, Horowitz may be argued to search the user-selected or user-marked text in a source document to identify key terms in the selected or marked text, and then to look up the identified terms in its knowledge database for the purpose of defining a tag that associates the key terms with a topic in the knowledge base. To confirm this, please see the following passages: column 8, line 50-53, which indicates that the user-selected portion is tokenized into words and/or word phrases; column 8, line 62 - column 9, line 16, which indicates that the tokenized words and/or phrases are parsed and unified and ultimately subjected to a selection process that yields a set of selected key terms; and column 9, line 28 - column 10, line 6 indicates that Horowitz looks up each selected key term in the knowledge base and creates tags associating topics in the knowledge base with the selected key term.

It is possible to argue that the identified key terms are predefined forms. However, Horowitz only appears to search the knowledge base for these identified key terms, not its source

document, or more generally, the document that the hyperlinks are inserted in. To confirm this, please see column 10, lines 12-21 in which Horowitz reports that its presentation module 150 receives the source document and the created tags and looks at the knowledge base to find the topic associated with each tag and then retrieves the URL (or other network location) for the knowledge-base document associated with found topic.

In addressing this requirement of searching for one or more predefined forms, the Examiner has stitched together two disparate portions of Horowitz. Specifically, the Examiner cited column 7, lines 1-67 as teaching "searching one or more documents" and column 3, lines 1-8 as teaching "for content matching predefined forms."

However, as applicant reads these passages, neither meets the requirement of "searching [the documents in which portions will be marked] for content matching predefined forms and marking the document based on the results of this searching." The column-7 passage reports a process of generating additional links for a user-selected portion of document while browsing or navigating web content.

Although searching possibly occurs in this process, the search is not for content in the source document that has predefined forms. Instead, the search is for target documents in the knowledge base that are related to the user-selected portion of the source document. See, for example, column 7, lines 19-23, which states: "[f]rom the selected portion 304 of the source document 300, a number of new contextual links to target documents 310 [in knowledge base] relevant to the selected portion 304 are generated. Thus, the cited searching is not for one or more predefined forms in the source document.

The passage at column 3, lines 1-8 states:

[This] allows a link in a source document to reference not only target documents that existed at the time the source document is initially authored, but also to new target documents or web content that is published after the source document is authored or published by the publisher. This allows the user to always have links from a document to relevant other documents that are on the Internet or a local intranet.

Nothing in this passage conveys a search of a source document for content having predefined forms. Instead, the passage conveys that links originally published in a source document can be

extended to target documents that were published after the publication of the source document.

In regard to the Examiner rearrangement of the text of Horowitz, applicant respectfully notes that MPEP §2131 states that an anticipatory reference must show the identical invention “in as complete detail as is contained in the . . . claim ... and that the elements must be arranged as required by the claim. Here, the Examiner has not only stitched together two disconnected passages, but also reversed their order of presentation. There’s no evidence in the record that the one of skill would regard Horowitz as teaching what the Examiner has attempted to derived by this stitching and rearrangement of Horowitz’ text. Indeed, as noted above, the passages taken in their original form and arrangement fail to meet the terms of the rejected claims.

Claims 1-5 also distinguish from Horowitz based on the required automatic marking of the documents that were searched for the predefined forms. In contrast, Horowitz reports manual marking or selection of content in a source document followed by searching based on the marked or selected content. To confirm this, please see again the column 2, lines 45-48 passage quoted above.

Accordingly, applicant urges respectfully that the Examiner reconsider and withdraw the §102 rejections of claims 1-5 and their dependents.

Claims 4, 6, and 17

Claims 4, 6, and 17 and their dependents require instructions for, an act of defining, or an act of generating “one or more hyperlinks, with each hyperlink including at least a portion of the content of [one or] one or more of the [automatically] marked portions of the documents.”

Regarding claim 6, the Examiner cites "each document has a URL [at] col. 3, lines 13-27" as meeting the requirement that each hyperlink including at least a portion of the content of one or more of the marked portions. And regarding claim 17, the Examiner cites Fig. 4c and col. 7, lines 19-31 for the statement that “new links are embedded directly in the text of the source document” and col. 10, lines 21-28 for the statement that the “links may be added directly in the text of the selected portion.”

However, neither of these cited passages meets the requirement that each hyperlink itself include content from the automatically marked portion of a document. The cited column-7

passages merely indicates that the hyperlinks are themselves embedded in the selected text of a document, not that any marked text from the document is embedded or included within the hyperlinks. In understanding this, one need only appreciate that the anchor term associated with a hyperlink is not itself within the hyperlink structure. The cited column-10 passage indicates that the text of the hyperlink may be inserted into the text of the document, presumably in a manner making visible the full text of the hyperlink within the text. No illustration is given for this type of insertion, but it seems reasonable to surmise that Horowitz intended that the entire text of a URL be spelled out in the document. However, this is different than defining a portion of the hyperlink to include text, for example, from an automatically marked portion of the document.

Claim 14

Claim 14 and its dependents require an act of “defining a hyperlink to point to one of at least two or more destinations based on one or more of the provided user preferences.” In response to this requirement, the Examiner cites col. 10, lines 22-34, stating “[t]he links may be added directly in the text of the selected portion... If there is more than one link for the tag, then a menu of links to target documents is created at the link anchor... with each link named by a simplified title.” However, the cited menu of links evidences an association of several fully defined hyperlinks with a single anchor term in the document, not an act of defining any of the hyperlinks based on user preferences. More particularly, Horowitz’s menu may allow a user to select from a list of hyperlinks, but none of the listed hyperlinks is itself defined based on user preferences. Still more particularly, none of the listed hyperlinks point to one of at least two or more destinations based on one or more of the provided user preferences as claim 14 requires.

Accordingly applicant respectfully requests that the rejection of claim 14 and its dependents be withdrawn.

Specific Dependent Claims

In addition to the distinctions noted above with respect to the independent claims, at least the following dependent claims further distinguish from Horowitz.

Claim 19, which stems from claim 1, requires that “the one or more predefined forms includes citations to printed publications.” In reference to this requirement, the Examiner cites that Horowitz teaches “the meta-data may include items such as document identifier, title, author, date, publication, industry codes, and the like” at col. 6, lines 13-27. However, this passage falls short of teaching one to search one or more documents for content having the predefined form of a citation to a printed publication. Indeed, there’s no indication that Horowitz searches the “meta data” for citations to printed publications, nor that Horowitz searches a document, in which hyperlinks are to be inserted, for meta data. Accordingly, there is at least one additional reason for withdrawing the rejection of this claim.

Claim 20, which also stems from claim 1, further requires that “one or more of the marked portions includes a citation to a document, the citation including a volume identifier, a page identifier, and a publication identifier, and wherein at least one of the generated hyperlinks includes the volume, page, and publication identifiers.” The Examiner cites a passage (col. 6, lines 13-27) regarding meta-data and URLs at column 6 as meeting this requirement. However, nothing in the cited passage indicates that Horowitz marks citations in the text of a document for which hyperlinks will be generated. Accordingly, there is at least one additional reason for withdrawing the rejection of this claim.

Claim 21, which also stems from claim 1, requires that “one or more of the generated hyperlinks includes at least one query connector.” The Examiner cites the passage at column 5, lines 43-48, as meeting this requirement via reference to user input queries. The passage, in full, states: “The user interface module 110 is responsible for providing a user interface to the information retrieval system 100 including receiving user input queries, displaying query results including hypertext documents, and receiving user selections of portions of any displayed document.” Nothing in this passage, nor any other that applicant could find in Horowitz, teaches one to include query connectors within a hyperlink. Accordingly, there is at least one additional reason for withdrawing the rejection of this claim and claims 33 and 46, which similarly recite “at least one query connector.”

Claim 22, also dependent on claim 1, recites that “one or more of the generated hyperlinks further includes at least one search instruction.” The Examiner cites Horowitz as

stating that “each document also has a network location, preferably specified as a uniform resource locator (URL) for accessing documents using the HyperText Transport Protocol (HTTP); col. 6, lines 13-27.” However, this statement fall short of teaching one to include a search instruction within a hyperlink. The statement refers to URLs, but the Action is devoid of any evidence that one of skill in the art would regard the referenced URL or network address as a search instruction or command. Indeed, it appears to be only an address. Accordingly, there is at least one additional reason for withdrawing the rejection of this claim.

Claim 23, also dependent on claim 1 recites that “one or more of the generated hyperlinks further includes a search-method identifier.” In reference to this requirement, the Examiner cites Horowitz’s “document identifier.” Yet, the Action is devoid of any evidence that one of skill in the art would regard a document identifier as identifying a search method. Accordingly, there is at least one additional reason for withdrawing the rejection of this claim and claims .

Claim 24, which stems from claim 23, further recites that “the search-method identifier identifies one of a natural-language search method and a boolean search method.” In reference to this requirement, the Examiner cites that “links are generated in response ... command at the time the resource document is accessed; col. 2, lines 62-67.” In full, the cited passage states

Where the links are generated in response to the user's access or command at the time the source document is accessed (rather than when the source document is authored by the publisher or instantiated by a search engine) both the terms that serve as the anchors of the links and the target documents of the links can be dynamically determined

Yet, the Action is devoid of any evidence that one of skill in the art would regard anything in this passage as an identifier for a boolean or natural language search method or that such identifier is part of a hyperlink . Accordingly, there is at least one additional reason for withdrawing the rejection of this claim and claims 35 and 47, which also recite “natural-language and boolean search methods.”

Claim 25, which stems from claim 1, recites that “one or more of the generated hyperlinks further includes account information for a user.” In reference to this requirement, the Examiner stated that “Horowitz teaches the meta-data; col. 6, lines 13-27. However, nothing in the cited passage refers to account information for a user. Indeed, the meta data appears related

to a document in database 140, not a particular user. In any event, the record is devoid of any evidence that one of skill in the art would regard Horowitz's meta-data as being account information for a user. Accordingly, there is at least one additional reason for withdrawing the rejection of this claim and claims 7, 36, and 48, which also recite "account information.")

Claim 26, which stems from claim 1, recites that "one or more of the generated hyperlinks further includes information identifying a third-party sponsor for facilitating access to a document in a database associated with the one hyperlink." In reference to this requirement, the Examiner cites "target documents are identified, preferably using a database which associates the terms with topics; col. 12, lines 24-37)." However, nothing in this statement appears to meet the requirement. Accordingly, there is at least one additional reason for withdrawing the rejection of this claim.

Conclusion

In view of the amended claims and remarks, applicant requests respectfully that the Examiner reconsider and withdraw all the rejections. Moreover, applicant invites the Examiner and her supervisor to telephone its patent counsel Eduardo Drake at (612-349-9593) to resolve any issues that may delay allowance.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

DOUGLAS T. ROSENOFF ET AL.

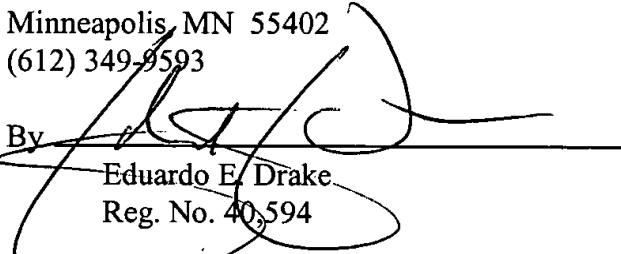
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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Box AF, Commissioner of Patents, Washington, D.C. 20231, on this 23rd day of August, 2002.

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